

Attorney Docket No.: 399483

REMARKS

Claims 1-34 are pending in the application. Claims 13, 15-19 and 24-34 are currently amended.

Applicant previously responded on July 14, 2004 and has received a notice of noncompliant amendment dated October 6, 2004. The present response overcomes the objections raised in the notice by adding status to the claims.

Claims 13, 15-19 and 24-34 have been amended to reflect changes in dependencies, as necessitated by the Office renumbering the claims.

The Office would restrict the claims into Groups I-V:

- I. Claims 1-13 and 20 drawn to a method and machine readable form for predicting soybean cyst nematode resistance;
- II. Claims 14-19, drawn to an electronically programmable apparatus for predicting soybean nematode resistance.
- III. Claims 21, 22, and 34 drawn to soybean seeds
- IV. Claims 23-32 drawn to a method for comparing genotypes via a predictive model;
- V. Claim 33 drawn to a plant breeding program.

Applicant elects Group I with traverse. Claim 23 is a linking claim, particularly where Groups I, II, IV and V share the commonality of using a predictive model, and the Group III claims address seeds that are selected by use of the predictive model. Claim 23 states the more general case for use of the predictive model.

The Office presently finds that Groups I, II and IV vs. Group V are unrelated as a process of making versus a process of using. We respectfully disagree because any process of making must precede the process of using what is made, as is reflected in the dependency of claim 33 from claim 23. Therefore, Group V is not properly restrictable from the linking claim.

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The Office finds that the Group III claims include any soybean seeds that may be evaluated, and so the claims are not allowable. We respectfully disagree because seeds may constitute patentable subject matter under 35 U.S.C. §101. Where the seeds have been evaluated and so generated by the method, there results an isolated population of seeds having the evaluated characteristics selected by the method. This is patentable, and the selected seeds are not distinct from the method where method is used to evaluate and select for inherent physical characteristics of certain seeds undergoing selection.

The Office finds that Groups I, II and IV are unrelated because it can be shown that the Groups are not disclosed as capable of use together, they have different modes of operation, different effects or different functions. The Office says, for example, that the Group I and Group II claims differ in the use of spectrophotometer practice as defined in Group I without requiring spectral scanning as defined in Group II. We respectfully disagree since both Groups recite the use and application of spectrographic data in a predictive model. All that has really occurred is recitation of an array of claims addressing this same general concept in different scope, where claim 23 (Group IV) is generic to all species. The Office finds that the scope of comparing spectra with a predictive model in Group IV differs from that recited in other Groups; however, this type of variation in scope is to be expected in a generic, linking claim and is not properly restrictable.

Applicant believes no fees are currently due. However, should any additional fees be required in connection with the filing of this Response, the Commissioner is hereby authorized to charge said fees to Deposit Account No. 12-0600.

Respectfully submitted



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